

REMARKS

The claims have not been amended. Accordingly, claims 1-2, 4-14, and 18-26 are currently pending in the application, of which claims 1, 8, 11 and 18 are independent claims.

Applicant requests reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Rejections Under 35 U.S.C. § 103

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007). Thus, even if the prior art may be combined, the references when combined must disclose or suggest all of the claim limitations. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-2, 4, 8-14, 18-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0111167 applied for by Nguyen *et al.* ("Nguyen") in view of U.S. Patent Application Publication No. 2003/0176205 applied for by Oota, *et al.* ("Oota"), further in view of U.S. Patent No. 6,493,431 issued to Troen-Krasnow, *et al.* ("Troen-Krasnow"), and still further in view of U.S. Patent Application Publication No.

2003/0092454 applied for by Halim, *et al.* ("Halim"). Applicant traverses this rejection for at least the following reasons.

"All of the Claim Limitations"

The cited references do not render the present invention obvious because, even assuming that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claims 1, 8, 11, and 18.

Claim 1

Specifically, Applicant respectfully submits that the cited references fail to disclose or suggest all features of claim 1. Claim 1 recites, in relevant part:

a messenger service system ...to send a second notification message to a personal computer, the second notification message to provide notification that the called mobile communication terminal is receiving the incoming message.
(emphasis added)

Nguyen, Oota, Troen-Krasnow, and Halim, either alone or in combination, fail to disclose at least these features.

The examiner concedes that the combination of Nguyen, Oota, and Troen-Krasnow "does not specifically disclose the second message for providing notification that the called mobile communication terminal is receiving the incoming message." Office Action, page 4 (emphasis in original). Applicant concurs, and incorporates the arguments on this point from the Reply filed on April 15, 2008 by reference.

To remedy the shortcomings of these references, the examiner then looks to Halim, and states that "Halim discloses sending ACKs when an SMS message is delivered to a user." Office Action, page 5 (emphasis in original). Applicant submits that this statement

mischaracterizes Halim. To the contrary, Halim explains that “the Delivery ACK or Manual ACK [is] transmitted by the mobile station 10 after message presentation to a user.” Halim, paragraph [0043] (emphasis added). Halim’s paragraph [0038] offers the examiner no additional leverage. In paragraph [0038], Halim explains that “the Delivery ACK is intended to be transmitted when a corresponding SMS message, which specifies Delivery ACK, is displayed to the user.” (emphasis added). Thus, according to Halim, the Delivery ACK is sent upon message display or presentation, is not “notification that the called mobile communication terminal is receiving the incoming message,” and therefore fails to remedy the identified shortcomings of Nguyen, Oota, and Troen-Krasnow.

Reply to Examiner’s Response to Arguments

The examiner does not appear to refute Applicant’s above-recited position regarding Halim, which was also presented in the Reply filed on October 14, 2008, and instead concludes that Halim’s disclosure “would enable a person of ordinary skill in the art to modify the combination in the format claimed by applicant.” Office Action, page 12. The purpose for this modification would have been to “serve the same purpose as applicant’s second message.” *Id.* This basis for modifying Halim, and the modification itself cannot be maintained. First, the examiner has acknowledged a shortcoming in Halim, and attempts to remedy the shortcoming by concluding, without support or even an explanation, that a person of ordinary skill in the art could have further modified Halim beyond what it explicitly disclosed. *Id.* Second, in contradiction of obviousness-type rejection principles, the examiner has relied upon nothing more than pure hindsight as a reason that would have prompted that person of ordinary skill in the art to combine the prior art elements in the manner claimed. *Id.* Thus, the examiner’s acknowledgement of Halim’s shortcoming remains unresolved.

Moreover, when citing to Halim, the examiner fails to note that in the well-known “concept of sending ACKs and NAKs,” an ACK message confirms delivery of the SMS message

to the sending device of the original SMS message and not to another device, such as a personal computer. Halim, paragraph [0038] (disclosing that the ACK is sent back to the SMS message sender if the “SMS message, which specifies Delivery ACK, is displayed to the user.”). There would have been no reason to modify the concept of “sending the second notification messages to a personal computer,” as allegedly disclosed by the combination of Nguyen, Oota, and Troen-Krasnow, with Halim’s ACK message, which reports delivery confirmation to a message sender. This shortcoming is relevant because the examiner looks to Troen-Krasnow to disclose sending the incoming call notification message to a personal computer operated by the intended message recipient. Office Action, page 4. Since Halim’s ACK message is sent to the message sender, rather than to a personal computer operated by the intended message recipient, there would have been no reason to modify the combination of Nguyen, Oota, and Troen-Krasnow with Halim’s ACK message to obtain the elements in the manner claimed.

For at least these reasons, the cited references do not render claim 1 obvious because, even assuming that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 1.

Claim 8

Similarly, Applicant respectfully submits that the cited references fail to disclose or suggest all features of claim 8. Claim 8 recites, in relevant part:

wherein the messenger service system sends a second notification message to a personal computer, the second notification message to provide notification that the called mobile communication terminal is receiving the incoming message.
(emphasis added)

For at least the reasons asserted above with respect to claim 1, Nguyen, Oota, Troen-Krasnow, and Halim, either alone or in combination, fail to disclose at least these features.

Specifically, the cited references fail to disclose “the second notification message to provide notification that the called mobile communication terminal is receiving the incoming message” (emphasis added).

For at least these reasons, the cited references do not render claim 8 obvious because, even assuming that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 8.

Claim 11

Applicant respectfully submits that the cited references also fail to disclose or suggest all features of claim 11. Claim 11 recites, in relevant part:

a messenger server to send a second notification message to a personal computer corresponding to the IP address,
wherein the second notification message provides notification that a called mobile communication terminal of the called subscriber is receiving an incoming message transmitted to a wireless communication system. (emphasis added)

For at least the reasons asserted above with respect to claim 1, Nguyen, Oota, Troen-Krasnow, and Halim, either alone or in combination, fail to disclose at least these features. Specifically, the cited references fail to disclose “the second notification message provides notification that a called mobile communication terminal ... is receiving an incoming message transmitted to a wireless communication system” (emphasis added).

For at least these reasons, the cited references do not render claim 11 obvious because, even assuming that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 11.

Claim 18

Applicant respectfully submits that the cited references fail to disclose or suggest all features of claim 18. Claim 18 recites, in relevant part:

providing notification to a personal computer
corresponding to the IP address that the called mobile
communication terminal is receiving the incoming message.
(emphasis added)

For at least the reasons asserted above with respect to claim 1, Nguyen, Oota, Troen-Krasnow, and Halim, either alone or in combination, fail to disclose at least these features. Specifically, the cited references fail to disclose “providing notification to a personal computer corresponding to the IP address that the called mobile communication terminal is receiving the incoming message” (emphasis added).

For at least these reasons, the cited references do not render claim 18 obvious because, even assuming that the cited references may be combined, the combined references fail to disclose or suggest all features of independent claim 18.

For at least these reasons asserted above, Nguyen, Oota, Troen-Krasnow, and Halim, either alone or in combination, fail to disclose every feature of claims 1, 8, 11 and 18.

“Scope of the Prior Art”

The cited references also fail to render the present invention obvious in view of the scope and contents of the prior art. Specifically, the examiner has failed to hurdle the gaps in the scope of the cited references.

Specifically, in combining Nguyen, Troen-Krasnow, Oota, and Halim, the examiner has examined discrete elements of claims 1, 8, 11, and 18 in isolation without considering the invention as a whole. Indeed, the Office Action offers no explanation how Oota’s incoming-call notifying function could be used to modify Nguyen’s system, which sends a message to a user

before an incoming call is received, and Troen-Krasnow's system, which sends a message after an incoming call is missed.

For example, the examiner relies on Oota to disclose "first and second notifications [that] are different from each other." Office Action, page 3. However, in Oota, the timings of the first and second notifications are also different. Specifically, the first notifying section is "for notifying an incoming call," while the second notifying section is "for notifying an unanswered incoming call" that has been canceled by the network. Oota, paragraph [0008]. The examiner explains that it would have been obvious to incorporate Oota's two notifications with Nguyen on the basis that "the user may be more responsive to the second type of notification, e.g., the user may have hearing impairment." Office Action, page 3. But this conclusion ignores the distinct purposes of Oota's two notifying sections, since the second notifying section emits light after an incoming call was canceled. Thus, Applicant traverses the examiner's conclusion that incorporating Oota's two notifications into Nguyen would have "increas[ed] the possibility of response by the user." Office Action, page 3. Oota's second notifying section would not have increased the possibility of response by the user because the second notifying section notifies a user that a call was already missed.

Further, the Office Action offers no explanation how Oota's incoming-call notifying function, Nguyen's system, which sends a message to a user before an incoming call is received, and Troen-Krasnow's system, which sends a message after an incoming call is missed, could be combined with Halim's Delivery ACK message, which is transmitted after the SMS message intended for a user is actually displayed or presented to the user.

Finally, as noted above at pages 10-11, the Office Action also fails to provide a valid reason why and the way in which Halim could be modified to be compatible with the combination of Nguyen, Oota, and Troen-Krasnow, so that Halim's Delivery ACK message,

which is normally sent back to a message sender, would provide “notification [to a personal computer] that the called mobile communication terminal is receiving the incoming message.”

In rejecting the present claims, the examiner has failed to consider how these four references with distinct purposes could be combined into a single system that would render claims 1, 8, 11, and 18 obvious when considered as a whole.

Claims 5-7

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nguyen in view of Oota, further in view of Troen-Krasnow, further in view of Halim, and still further in view of U.S. Patent Application Publication No. 2004/0253975 applied for by Shiraogawa, *et al.* (“Shiraogawa”). Applicant respectfully traverses this rejection for at least the following reasons.

Applicant respectfully submits that claim 1 is allowable over Nguyen, Oota, Troen-Krasnow, and Halim as set forth above, and Shiraogawa fails to cure the deficiencies noted above with regard to claim 1. Hence, claims 5-7 are allowable at least because they depend from an allowable base claim.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 8, 11 and 18. Claims 2, 4-7, 9-10, 12-14, and 19-26 each depend from one of these independent claims and are allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicant respectfully submits that independent claims 1, 8, 11 and 18, and all the claims that depend therefrom, are allowable.

CONCLUSION

A full and complete response has been made to the pending Office Action and all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, all pending claims are allowable and the application is in condition for allowance.

The Examiner is invited to contact Applicant's undersigned representative at the number below if it would expedite prosecution. Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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